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EXAMINER

GANTT, ALAN T

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/891,912

Applicant(s)

MANKOVITZ, ROY J.

Examiner

Alan T. Gantt

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26 and 50-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 and 66-95 is/are allowed.
- 6) ☒ Claim(s) 50-52, 54, 55 and 57-65 is/are rejected.
- 7) ☒ Claim(s) 53 and 56 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/290,012.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 50-52, 59-62, and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Irribarren.

Regarding claim 50-52, 59-62, and 65; Irribarren discloses an interface system and method for interconnecting a voice message system and an interactive response system. Irribarren includes a computer-accessed database that comprises a voice message system, a text message system, and a facsimile receiving, transmission and storage system. Irribarren allows for callers not related to the system to call by telephone [callers of the first type], and if the called party is not available, the automated interactive voice response system communicates with the

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caller and may leave a voice message with information that includes symbols such as a telephone number where the caller can be reached. Also, Irribarren allows a remote user with ties to the system [callers of the second type] to use a telephone to contact the system and have previously stored messages read to him over the telephone. In operation, this caller of the second type calls the system, logs in via a user name and password [i.e., giving the system supplemental information about himself and getting replies from the system regarding whether there are any messages for him, and what form they are stored], and is prompted to use the touchtone keypad to command the system to accomplish specific function. By touchtone command, the user may request that any left messages be played back via the text, voice or speech translation subsystem. Replies are accomplished by requesting the system send canned message to the sender's electronic mail address. A network is disposed between a computer database accessing means for storing and retrieving text messages and a voice message means for storing and retrieving voice messages. There is an interface apparatus for connecting each system to the telephone lines, i.e., linecards, TTS, and FAX input/output ports are connected together such that a single telephone line may access both systems (col. 4, lines 6-21 and col. 5, lines 5-23). Either caller type calling the system may receive pre-recorded prompts. The "type 2" caller will get a prompt menu that enables him to command the system. Because of the FAX capabilities of the system, the type 1 caller may send a fax to the type 2 caller's FAX storage mailbox allowing for a printed message including one or more numeric or alphanumeric characters identifying the message since inherent to the facsimile art, the fax hard copy print-out will include time of day, the fax number from which the fax was sent [thus, automatically yielding the geographical location of the caller, and maybe a sequence number (col.5, line 60 to col. 6, line 8). Also, this

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aspect of Irribarren allows the caller to send certain supplemental information about the himself, what type of reply or information he is seeking. The printed message may contain the characters in the form of written words that convey what reply the caller is seeking. With the supplemental information the "type 2" caller can provide the appropriate reply for the type 1 caller.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54, 55, 57, 58, 63, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irribarren.

Regarding claims 54 and 55, Irribarren discloses a method of replying to a telephone caller as stated above for claim 50. However, Irribarren is silent regarding whether the supplemental information includes the geographic location of the caller.

The examiner takes official notice that it is well known in the art that communications that involve facsimile contain the number from which the FAX was sent and that the printed hard copy fax could include within the message other information regarding the location of the caller and that it would have been obvious at the time of the applicant's invention to include the telephone number information provided by the facsimile communication as it would allow for automatic outside caller-location-databasing.

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Regarding claim 57, the examiner takes official notice that it is well-known that a fax message could be an advertisement and that it would have been obvious at the time of the applicant's invention that a message seeking a reply would be solicitation from an advertisement because the caller could be seeking business ties.

Regarding claim 58, the examiner takes official notice that it is well-known that the telephone used by an outside caller could be a wireless type since at the time of the applicant's invention it would have been obvious that the caller would use such a device for its convenience.

Regarding claim 63, Irribarren allows for the caller to connected to a human operator and obviously, this allows for the prospect that the caller's reply could be taken care of during the telephone call since the issues could be brought forth in the instant conversation.

Regarding claim 64, Irribarren states that one of the advantages of his invention is that the text message system and voice message system are connected by a network, thus, negating the requirement that separate telephone calls are needed to access both systems. Thus, the caller is automatically patched to an additional phone call

***Allowable Subject Matter***

Claims 26 and 66-95 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

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Regarding claims 26 and 66, the limitation regarding "a database storing information relating to a plurality of replies correlated to the message" was neither found, suggest, nor made evident in the relevant prior art.

Regarding claim 82, methods relating to providing a telephone caller with additional information about a billboard advertisement were neither found, suggested, nor made evident in the relevant prior art.

Claims 53 and 56 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 53 and 56, messages regarding billboards and their unique locations was neither found, suggested, nor made evident by the relevant prior art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brunson discloses an electric messaging system that allows a plurality of customized announcement messages.

Mitchell et al. discloses a voice response with automated data transfer for providing interactive data exchange between an outside party, an operator, and one or more databases.

McNutt discloses a system for taking and retrieving telephone messages used with a PBX and that includes a central computer and operator stations.

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Any inquiry concerning this communication from the examiner should be addressed to Alan Gantt at telephone number (703) 305-0077. The examiner can normally be reached between 9:30 AM and 6 PM within the Eastern Time Zone. The group FAX number is (703) 308-6306.

Any inquiry of a general nature or relating to this application should be directed to the group receptionist at telephone number (703) 305-4700.

Alan T. Gantt

December 14, 2002

*Alan Gantt*  
ALAN GANTT  
PATENT EXAMINER